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No. 88-432

IN THE

Supreme Court of the United States

OCTOBER TERM, 1988.

GABRIEL ELECTRONICS, INC.,

Petitioner,

v.

ANDREW CORPORATION,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

RESPONDENT'S BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

I. Did the Federal Circuit err in applying 35 U.S.C. § 112, second paragraph, to the particular facts of this case, using the well established legal principles which state that patent claims are not invalid for indefiniteness if the claim language clearly distinguishes what is claimed from what went before in the art, reasonably apprises those skilled in the art of the utilization and scope of the invention, and is as precise as the subject matter permits? *See, e.g., Eibel Process Co. v. Minnesota & Ontario Paper Co.,* 261 U.S. 45 (1923); *United Carbon Co. v. Binney & Smith Co.,* 317 U.S. 228 (1942).

II. Did the Federal Circuit violate the "clearly erroneous" standard of Federal Rule of Civil Procedure 52(a) by reversing the district court's decision on a question of law, and pointing out that the proper conclusion of law was supported by certain of the district court's own findings of fact on other issues, and certain evidence of record not considered by the district court?

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RESPONDENT'S BRIEF IN OPPOSITION

The Respondent Andrew Corporation[1] respectfully requests that this Court deny the petition for writ of certiorari, seeking review of the Federal Circuit's opinion in this case. That opinion is reported at 847 F.2d 819, 6 U.S.P.Q.2d 2010.

COUNTERSTATEMENT OF FACTS

The Knop patent at issue covers a valuable advance in the complex art of horn-reflector microwave antennas. The Knop

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[1] Pursuant to Rule 28.1 of the Supreme Court Rules, Respondent Andrew Corporation represents that it is a Delaware corporation having VSAT Systems, Inc., Antenas de Transmision S.A. de C.V. and SciCom Scientific Communications, Inc. GMBH as affiliates.

invention provides an antenna that produces radiation pattern envelopes (RPEs) that are very similar in two perpendicular planes, commonly referred to in the industry as the "E" and "H" planes. The district court found that in actual operation and testing of such antennas, "curves showing RPEs for horn antennas will never be identical." The claims of the Knop patent state that these RPE's "approach each other" (claims 1 and 5), are "close to" each other (claim 2), are "substantially equal" to each other (claim 3) or "closely approximate" each other (claim 6).

The district court held the claims of the Knop patent invalid only on the legal ground of indefiniteness under 35 U.S.C. § 112, second paragraph. The Federal Circuit reversed, concluding as a matter of law that the Knop patent claims defined the invention in words "as precise as the subject matter permits" and sufficient to "reasonably apprise those skilled in the art of the scope of the invention."

REASONS WHY THE PETITION SHOULD BE DENIED

1. Introduction

This case involves a routine dispute about the validity and infringement of certain patents. Neither question presented by petitioner meets the criteria of Rule 17, or in any other way warrants review by this Court.

Petitioner's first question, relating to the legal sufficiency of the description of Respondent's patent claims, does not even purport to discover a conflict between the Federal Circuit and any other Circuit court, which is not surprising given the Federal Circuit's exclusive appellate jurisdiction in this area. Nor does the Federal Circuit's decision break new ground that requires this Court's attention, or conflict with any applicable decisions of this Court with respect to patent claims.

Petitioner's second question erroneously suggests that the Federal Circuit ignored the "clearly erroneous" rule in its examination of the district court's ruling. This is simply inaccurate. The Federal Circuit carefully observed the distinction between findings of fact and conclusions of law, and reviewed the lower court's decision accordingly.

The total absence of any reason for this Court's review of the Federal Circuit's patent decision makes this case a singularly inappropriate candidate for the exercise of the Court's discretionary power.

2. **The Federal Circuit correctly applied statutory and decisional standards governing the use of terms of degree in patent claims.**

No one disputes the fact that 35 U.S.C. § 112, second paragraph, requires patent specifications to conclude "with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." The Federal Circuit carefully evaluated the facts found by the trial court about the technological field covered by the Knop patent and concluded, as a matter of law, that the patent satisfied the statutory standard.

It is well settled that invalidity under 35 U.S.C. § 112, second paragraph, is a question of law. *See, e.g., Graham* v. *John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Specialty Composites* v. *Cabot Corp.*, 845 F.2d 613, 6 U.S.P.Q.2d 1601, 1604 (Fed. Cir. 1988) ("Claim interpretation is a matter of law.").

Petitioner contends in effect that the use of *any* term of degree in a patent claim renders the patent invalid. This extreme contention directly contradicts well established legal principles developed by this Court in decisions dating back more than 50 years, and in numerous decisions by various Circuit courts following the decisions of this Court. In addition, a number of decisions by this Court have

expressly approved patent claims using terms of degree, as will be pointed out in detail below.

The decisions of this Court that developed the legal principles adhered to by the regional Circuit courts, and more recently by the Federal Circuit, include the *United Carbon*[2] case cited by petitioner. *United Carbon*, however, is just one of the line of Supreme Court cases that developed the principles now followed by the lower courts when evaluating the validity of patent claims attacked on the ground of "indefiniteness." Other cases in that line include *Minerals Separation, Ltd.* v. *Hyde*, 242 U.S. 261 (1916); *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.*, 261 U.S. 45 (1923); *Smith* v. *Snow*, 294 U.S. 1, (1934); *General Electric Co.* v. *Wabash Corp.*, 304 U.S. 364 (1938); and *Standard Brands* v. *Yeast Corp.*, 308 U.S. 34 (1939).

Contrary to petitioner's arguments that the Federal Circuit decision here "ignored" *United Carbon*, the Federal Circuit decision is in complete accord with *United Carbon* and the entire line of cases cited above. The Federal Circuit opinion here applied the legal principles it quoted from *Georgia-Pacific Corp.* v. *United States Plywood Corp.*, 258 F.2d 124, 136, 118 U.S.P.Q. 122, 132 (2d. Cir.) *cert. denied*, 358 U.S. 884 (1958):

> If the claims, read in the light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.

The *Georgia-Pacific* case in turn cited *United Carbon*, so it is disingenuous for petitioner to urge that this statement of the law "ignores" *United Carbon*. In addition to *United Carbon*, *Georgia-Pacific* cited two Court of Appeals decisions as direct precedent for the rule of law articulated in the above quotation. Those two decisions were *Lever Bros. Co.* v.

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[2] *United Carbon Co.* v. *Binney & Smith Co.*, 317 U.S. 228 (1942)

Procter & Gamble Mfg. Co., 139 F.2d 633, 639 (4th Cir. 1943), and *H.H. Robertson Co.* v. *Klauer Mfg. Co.*, 98 F.2d 150, 153 (8th Cir. 1938).

The *Lever Bros.* court also cited *United Carbon*, along with most of the other Supreme Court cases cited above, as establishing the same legal principles articulated in *Georgia Pacific*. The *H.H. Robertson* court cited the Supreme Court's decision in *General Electric, supra*. Thus, there is an abundance of Supreme Court precedent directly underlying the precise statement of law followed by the Federal Circuit here and quoted from *Georgia-Pacific*.

The differences in the results reached in various cases arise solely from the differences in the facts involved in the respective cases, not from any differences in the law applied. The law has remained remarkably consistent in this area, and the effect of the Federal Circuit decision here is to maintain that consistency.

The specific criteria applied by this Court and the various Circuit courts in all the above cases were the same as those applied by the Federal Circuit in the present case. Those criteria included consideration of whether the claim language clearly distinguishes what is claimed from what went before in the art, whether that language reasonably apprises those skilled in the art of the scope of the invention, and whether the claim language is as precise as the subject matter permits.

The district court in the present case erred in failing to apply the above criteria to certain highly relevant facts, including findings of fact that the district court itself made in its analysis of other issues in the case. For example, the Federal Circuit opinion points out that:

> [I]ndeed the [district] court found that it "became very clear during trial . . . that curves showing RPEs for horn antennas will never be identical." Words similar to those used in the Knop claims appear in prior art

> patents that were of record in the district court, dealing with similar technology.

As mentioned above, this Court has expressly approved patent claims using terms of degree. For example in *Eibel Process, supra,* this Court approved the use of the terms of degree "substantial" and "high" on the basis of evidence that persons skilled in the art would understand the terms in question:

> This patent and its specifications were manifested to readers who were skilled in the art of paper making and versed in the use of the Fourdrinier machine. . . . Expressions quite as indefinite as "high" and "substantial" in describing an invention or discovery in patent specifications and claims have been recognized by this Court as sufficient. [citations omitted]

261 U.S. at 65-66.

More recently, in *Diamond* v. *Diehr*, 450 U.S. 175 (1981), this Court analyzed and approved patent claims which defined a method of operating a rubber-molding press, using terms such as "at a location *closely adjacent* to the mold cavity," performing calculations "at *frequent* intervals," heating the mold to "a temperature range *approximating* a predetermined rubber curing temperature," and opening the press when a comparison of two time periods "indicates *equivalence*." The Federal Circuit has also repeatedly approved patent claims using such terminology. As stated in the Federal Circuit's opinion in the present case, such terms "are ubiquitous in patent claims."

It is interesting that petitioner would contend that the Federal Circuit's decision in the present case is contrary to the Federal Circuit's decision in *Seattle Box*[3] when the Court of Appeals' opinion in the present case actually cites and quotes from *Seattle Box*. In fact, the specific language

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[3] *Seattle Box Co., Inc.*, v. *Industrial Crating and Packaging, Inc.*, 731 F.2d 818 (Fed. Cir. 1984).

quoted from *Seattle Box* in the Federal Circuit's opinion in the present case makes the precise point that petitioner says the panel ignored, i.e., that the acceptability of a term of degree depends on "whether one of ordinary skill in the art would understand what is claimed . . . in light of the specification."

Thus, the Federal Circuit's decision here does not represent any departure from either its own precedent or that of this Court.

3. The Federal Circuit correctly reviewed the district court's conclusions of law, and gave due deference to its findings of fact.

In arguing that the Federal Circuit allegedly "ignored" the clearly erroneous standard of Federal Rule of Civil Procedure 52(a), petitioner repeatedly mischaracterizes conclusions of law as findings of fact. Its claim that the court of appeals failed to follow the per curiam ruling in *Dennison Manufacturing Co.* v. *Panduit Corp.*, 475 U.S. 809 (1986), is all the more surprising in light of the court's explicit reliance on the clearly erroneous standard where it was properly applicable. (See, e.g., pet. app. at 10a, concluding that the district court's findings concerning inequitable conduct had not been "shown to be clearly erroneous"; at 4a, affirming the decision of infringement of the Knop patent because "no clear error" was shown; and at 15a, affirming the decision of noninfringement of the Dawson patent because "we discern no clear error in the court's analysis.")

The question throughout the proceeding had to do with the legal sufficiency of the claims. It was the trial court's application of law to fact, and its decisions on which facts were pertinent and which were not, that the appellate court was reviewing. Nothing in *Dennison* or any other decision of this Court required it to defer to the district court on these matters. To the contrary, in *Graham* v. *John Deere Co., supra,* this Court characterized the "ultimate question" of patent validity as one of law. In *Bose Corp.* v. *Consumers*

Union of U.S., Inc., 466 U.S. 485, 501 (1984), this Court reaffirmed that Rule 52(a)

> does not inhibit an appellate court's power to correct errors of law, including those that may infect a so-called mixed finding of law and fact, or a finding of fact that is predicated on a misunderstanding of the governing rule of law.

See also *Anderson* v. *City of Bessemer City, N.C.*, 470 U.S. 564 (1985); *Pullman-Standard* v. *Swint*, 456 U.S. 273 (1982); *Amadeo* v. *Zant*, 108 S.Ct. 1771 (1988).

Thus petitioner is incorrect when it characterizes the district court's conclusion regarding the language in the Knop claims as a "finding of fact." It was plainly a conclusion of law that the Federal Circuit reviewed, and the factual basis for the reversal of the district court's conclusion is specifically pointed out in the Federal Circuit opinion.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted,

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